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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,984	03/08/2002	Richard D. Schile	J576-001 CIP	2596

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/683,984

Applicant(s)

SCHILE, RICHARD D.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 7-10, 13 and 15-21, drawn to a composition comprising a mixture of an imidazole or a 4-alkylphenol/formaldehyde product, trimethylolpropane and a tetramethylguanidine (adduct), classified in class 252, subclass 182.26.
- II. Claims 3, 5, 6, 11, 12 and 15-17, drawn to the composition of Invention I and an accelerator, classified in class 525, subclass 504
- III. Claim 4 and 14, drawn to the composition of Invention I and a polyhydric phenol component, classified in class 525, subclass 486.

The inventions are distinct, each from the other because:

Inventions I and (II or III) are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a curing agent for a carboxyl-functional polyester and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Invention II is distinct from Invention III because the accelerator of Invention II is a structurally distinct reactive component from the polyhydric phenol of Invention III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

- 1) The compositions containing either the imidazole or the 4-alkylphenol/formaldehyde product for component a).
- 2) The compositions comprising either tetramethylguanidine or a tetramethylguanidine adduct as component c) of claim 1 or as the tertiary amine of claim 7. If the tetramethylguanidine adduct is elected, the compound to be adducted should be identified such as the diglycidylether of claim 18 or 19.

3) Contingent upon the election of Invention II, items 1) and 2) hereinabove and either the p-cresol/diethanolamine/formaldehyde adduct or the p-cresol/dimethylaminopropylamine/formaldehyde adduct of claim 6 as the accelerator.

4) Contingent upon the election of Invention III, items 1) and 2) hereinabove and the election of a single species of polyhydric phenol from claim 4.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species within each of the appropriate items 1) to 4) hereinabove for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-21 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Mark A. Conklin on May 1 and August 18, 2003 to request an oral election to the above restriction and election of species requirement, but did not result in elections being made. The reply to this requirement to be complete must include elections of the invention and species to be examined even though the requirement be traversed (37 CFR 1.143).

There is no clear line of distinction between the bisphenols and dihydric phenols, the adduct of a bisphenol with 1-2 moles of a monoglycidyl compound and the adduct of a dihydric phenol with 1-2 moles of a monoglycidyl compound, as well as the adduct of a bisphenol with 2 moles of trimethylolpropane and the adduct of a dihydric phenol with 1-3 moles of trimethylolpropane in claims 4, 13 and 14. The dihydric phenol embraces the bisphenol which is a species of dihydric phenol. The deletion of the bisphenol species from the claims and their presentation in separate new claims would overcome this potential violation of 35 U.S.C. 112, second paragraph.

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